UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARLOS PEDRIDO and BERNARD LEUENBERGER

Appeal No. 2005-0584
Application No. 09/745,414

HEARD: March 09, 2005

Before OWENS, KRATZ and TIMM, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 10. Claims 1-9 and 11-15, which are all of the other claims pending in this application, have been indicated as being allowable by the examiner.

BACKGROUND

Appellants' invention relates to an inlet arrangement for inserting a preform into a fiber drawing furnace. An understanding of the invention can be derived from a reading of appealed claim 10, which is reproduced below.

10. An inlet arrangement for inserting a preform into a furnace for drawing fiber, comprising:
an inlet;
an outlet downstream of the inlet,
a first conveying path through the inlet arrangement extending from the inlet to the outlet, the first conveying path for conveying the perform body from and through the inlet to and through the outlet;
a first seal;
a closure member located downstream of the inlet and between the first seal and the outlet, the closure member selectively moveable between a closed position that closes and seals the first conveying path and an opened position that opens and unseals the first conveying path; and
an injector located downstream of the closure member and between the closure member and the outlet, the injector for injecting a gas into the first conveying path of the inlet arrangement.

The sole prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Nicholson et al. (Nicholson) 5,713,979 Feb. 03, 1998

Claim 10 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Nicholson.

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by appellants and the examiner concerning the issues before us on this appeal.

OPINION

Upon review of the entire record including the respective positions advanced by appellants and the examiner with respect to the rejection that remains before us, we find ourselves in agreement with appellants since the examiner has failed to carry the burden of establishing a prima facie case of anticipation. Accordingly, we will not sustain the examiner's stated rejection on this record substantially for reasons set forth in appellants' briefs.

The examiner has the initial burden of establishing a prima facie case of anticipation by pointing out where all of the claim limitations appear in a single reference. See In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138-39 (Fed. Cir. 1986). In order for a claimed invention to be anticipated under 35 U.S.C. § 102, all of the elements of the claim must be found in one reference. See Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Here, the examiner has not convincingly explained where Nicholson describes a structure which falls within the scope of appealed claim 10. Therefore, the examiner has not carried the

initial burden of establishing a prima facie case of anticipation of the claimed invention.

Concerning this matter, we note, for example, that appellants' claimed inlet and outlet are part of an arrangement useful for inserting a preform into a fiber drawing furnace. The examiner asserts that "the top of Nicholson's 8 is an inlet" corresponding to appellants' claimed inlet (answer, page 5). As correctly explained by appellants (reply brief, pages 4 and 5), the element labeled with reference numeral (8) in drawing figure 1 of Nicholson is a vacuum feed-through that permits vertical movement of a shaft (7) of the induction-heated furnace disclosed in the reference. The examiner has not established that an opening exists between the shaft (7) and vacuum-feed through (8) of Nicholson or that Nicholson discloses removing the shaft and leaving the feed through (8) open while furnace A is attached to furnace B and chamber C. Nicholson further provides that section A of the furnace is loaded/unloaded of a soot body through the lower end thereof, not through the vacuum feed-through. See column 10, lines 14-17 and drawing figure 2 of Nicholson. Consequently, while the examiner asserts that element (8) of Nicholson corresponds to appellants' claimed inlet that permits conveying a preform body therethrough, the examiner has not

pointed to any disclosure of Nicholson that reasonably ascribes such a capability to the vacuum feed-through element as arranged in Nicholson's device.[1]

In addition, we further note that the examiner has not established where Nicholson describes an injector located as claimed. In this regard, the alternative pipework arrangements referred to at column 9, lines 1-4 of Nicholson do not specifically require an injector that is located between a closure member and an outlet as appellants' claim. Even if we could agree with the examiner that selecting an injector and locating the injector to feed gases directly into furnace section B of Nicholson would be one such alternative pipework arrangement, such a selection is not permissible under 35 U.S.C. § 102. While some picking and choosing may be entirely proper in making an obviousness rejection under Section 103, it has no place in making a Section 102 rejection for anticipation. See In re Arkley, 455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972).

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[1] While the examiner maintains that claim 10 does not set forth a size limit for the preform, we note that claim 10 does require that the inlet be sufficiently sized for passing a preform body that is of a type useful for drawing fiber therefrom.

Accordingly, on this record, the examiner has not established a sustainable § 102(b) rejection.

CONCLUSION

The decision of the examiner to reject claim 10 under 35 U.S.C. § 102(b) as being anticipated by Nicholson is reversed.

REVERSED

TERRY J. OWENS Administrative Patent Judge	)	
PETER F. KRATZ Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
CATHERINE TIMM Administrative Patent Judge	)	

PFK/sld

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